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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

Applicant: Robert B. Hope
Serial No.: 10/033,518
Filed: 12/28/2001
For: WEATHER SEAL HAVING ELASTOMERIC MATERIAL
ENCAPSULATING BENDABLE CORE
Examiner: Jerry E. Redman Art Unit: 3634
Atty Docket: ULB-003CV

RESPONSE TO OFFICE ACTION DATED 01/23/2003

Box AF
Commissioner for Patents
Washington, D.C. 20231

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Dear Sir:

In response to the Office Action of January 23, 2003, please consider the following:

The elements of the listed headings is in the specification. The use of subheadings is optional, and use thereof is not elected. The suggestion to use subheadings is gratefully acknowledged.

The only rejection in the case is under 35 U.S.C. §102 (anticipation) which requires all elements claimed in each claim to be in the reference (Weichman '233).

To establish that the claims are anticipated, each and every element of these claims must be described in a single prior art patent or printed publication. See Applied Med. Resources Corp. v. United States Surgical Corp., 147 F.3d 1374, 1378 (Fed. Cir. 1998)(affirming judgment as a matter of law of validity), cert. Denied, 119 S. Ct. 870 (1999); see also United States Filter Corp. v. Ionics, Inc., 68 F. Supp. 2d 48, 52 (D. Mass. 1999). Applicant respectfully submits that Weichman fails to meet this exacting standard.

Claim 1 calls for a substrate of recycled elastomeric material and a covering of virgin elastomeric material. This is clearly absent in Weichman. Claims 3 and 4 contain further limitations to the recycled material and the form thereof.

Claim 8 further limits Claim 3 to reinforcement elements on only one side of the core. Weichman has them on both sides.

Claim 5 is limited to longitudinal extension control elements along one side of said core. As noted, this construction is not in Weichman.

Claims 5, 6, 7, 9 and 10 are product by process claims for such claims process limitations cannot be ignored. With all due respect, therefore, the statement that Applicant argues limitations not in the claims is in error. As noted below, the distinguishing features over Weichman are in the claims and process of making features cannot be ignored in product by process claims.

The law does not permit an interpretation of Weichman on which anticipation can be based. A patent claim is anticipated only if a comparison of the claimed invention with a single prior art reference establishes clearly and convincingly that every element in the claim is "described, organized, and functioning in substantially the same manner as in the prior art reference." Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989, 996 (Fed. Cir. 2000) (affirming jury finding of no anticipation); Biacore, AB v. Thermo Bioanalysis Corp., 79 F. Supp. 2d 422, 459 (D. Del. 1999) (finding patent not anticipated and infringed).

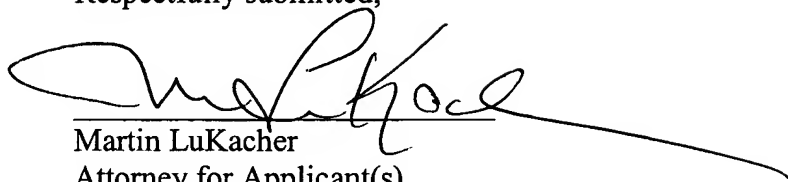
Whether a specific reference anticipates a patent claim "is a question of fact." Rockwell Intern. Corp. v. U.S., 147 F.3d 1358, 1363 (Fed. Cir. 1998). To establish a *prima facie* case of anticipation, the Examiner must prove, therefore, with respect to the claims, that a single prior art reference describes all of the claimed subject matter in its entirety. That description in the prior art reference must contain sufficient detail and clarity to demonstrate that the claimed subject matter existed prior to the invention, and that a person of ordinary skill in the art would have recognized its existence in the proffered prior art reference. See Helifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 1346-47 (Fed. Cir. 2000) (vacating grant of summary judgment of invalidity by anticipation).

Accordingly, there is no anticipation by Weichman. With all due respect, the Examiner has ignored salient limitations in the claims which provide significant improvements in weather seals of the type having wire and similar cores, including Weichman's, all as explained in the specification.

Early allowance is respectfully solicited.

Respectfully submitted,

Dated: February 11, 2003


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